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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 RECORD OF ORAL HEARING

2
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES

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10 *Ex parte* MARK JAMES KLINE, DONALD CARROLL ROE,
11 and ANN MARIE SULLIVAN

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14 Appeal 2008-4254
15 Application 09/778,687
16 Technology Center 1700

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19 Oral Hearing Held: January 15, 2009

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22 Before DEMETRA J. MILLS, RICHARD M. LEBOVITZ, and
23 FRANCISCO C. PRATS, *Administrative Patent Judges*.

24
25 ON BEHALF OF THE APPELLANTS:

26
27 AMY M. FOUST, ESQUIRE
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32
33 The above-entitled matter came on for hearing on Thursday,
34 January 15, 2009, commencing at 1:41 p.m., at the U.S. Patent and
35 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before
36 Patricia A. Edwards, RPR, Notary Public.

PROCEEDINGS

JUDGE MILLS: Okay. You can begin when you're ready, and you have 20 minutes.

MS. FOUST: Okay. Good afternoon. Thank you for your time today. My name is Amy Foust. I represent the Procter & Gamble Company, which is the assignee of the entire interest in Application Number 09/778,687.

The claims in this case are directed to a changing aid comprising, among other things, an effect-generating mechanism which is adapted to transform at least a portion of an article adapted to be worn externally on a body of a wearer, or to draw from one of the more concrete examples, a device to facilitate the changing of a disposable absorbent article or diaper.

What I'd like to do today is to walk through the claim language briefly, at least for the one independent claim pending in this case, and then talk about how the interpretation of the claims impacts the 102(b) rejections on the record.

JUDGE LEBOVITZ: Can I ask you a question? You said to change
diapers. What else could it be used for?

MS. FOUST: I believe some of the other examples in the specification include things like panty liners, bandages, wound-care products, those sorts of things. They're all in the specification.

JUDGE LEBOVITZ: Okay. So something that would wrap around a body part?

MS. FOUST: Potentially. Although a panty liner might not.

JUDGE LEBOVITZ: Okay.

1 MS. FOUST: If we look at claim 19, which is the only independent
2 claim in this case, it recites a changing aid comprising a mat and at least one
3 effect-generating mechanism joined to the mat.

4 The effect-generating mechanism is adapted to transform at least a
5 portion of an article, and that article is adapted to be worn externally by the
6 wearer.

7 And one of the claim-interpretation issues that has come up in this
8 case is whether the changing aid can be a portion of the article. And I want
9 to suggest that there is nothing in the language of the claim which suggests
10 the two overlap or are joined or connected.

11 And in fact, the specification consistently refers to them as separate
12 elements or separate structures, separate constructs. The changing aid and
13 the article are always referred to as separate entities.

14 And so we believe that the claims as interpreted in light of the
15 specification actually recite two distinct pieces, a changing aid and a
16 separate article which is adapted to be worn.

17 JUDGE LEBOVITZ: But that doesn't exclude the changing aid to be
18 incorporated within the article.

19 MS. FOUST: What doesn't exclude it?

20 JUDGE LEBOVITZ: The claim. It says it -- even if you look at the
21 spec and you're saying the specification refers to a changing aid and it refers
22 to an article as separate items, I guess I'm saying what language in the claim
23 would exclude that separate changing aid to be placed within the article?

24 MS. FOUST: I think the language of the claim is meant to suggest
25 that they're separate, and we have to interpret that language in light of the

1 specification. And I don't read any of the examples or the embodiments in
2 the specification to provide for a combined element.

3 So if we approach it in a different way, I think if I tried to amend the
4 claim to specifically require that they were combined, I would potentially
5 have a written-description problem because I don't read any of the
6 embodiments in the spec or anything in the spec to say that they are, in fact,
7 the same thing.

8 JUDGE MILLS: Do we have any specific definition of changing aid,
9 any limited definition of changing aid?

10 MS. FOUST: I believe if you start as early as page 2 in the
11 specification, it's discussed generally. There's no place that I can think of
12 immediately where it's laid out very specifically.

13 However, if you look at some of the embodiments, there's also
14 language which suggests that most of the embodiments contemplate two
15 separate parts.

16 So on page 7, there's a discussion about an article which may include
17 an effect-receiving element, sort of the counterpart to the effect-generating
18 mechanism. That wouldn't be necessary if they were all part of one unit or
19 one structure. The effect-generating mechanism is simply for more than one
20 component.

21 Similarly, on page 8, there's discussion of a connection between the
22 aid and the article as an alternate effect of the effect-generating mechanism,
23 so the idea that they're connected during the application or removal process
24 as the affect of the mechanism.

25 And another example appears on page 9 where we talk about
26 coordinating the positions of the article and the external change aid, which,

1 again, coordinating with those positions would not be necessary if they were
2 joined or if they one piece, basically; if they were all combined.

3 Another point of contention that has arisen is over transformation.
4 And a transformation has been explicitly defined in the specification and
5 much of that language has now been pulled into the claim through
6 amendment.

7 And so the transformation is from a first condition -- this is in the
8 claim -- from a first condition to at least one second condition.

9 And then we have a sort of laundry list of changes that would satisfy
10 that first condition to second condition: A size, a thickness, absorbency --
11 we can go through -- or by making a connection between the portion of the
12 article and another portion of the article, or by activating or deactivating an
13 adhesive.

14 And finally, we have this last clause in the claim that this
15 transformation is occurring during an application of the article onto the body
16 or removal of the article from the body to thereby assist in the application or
17 removal. So it is envisioned that this is taking place during -- while you're
18 putting on the bandage, a diaper, a panty liner, or while you're removing it.

19 JUDGE LEBOVITZ: But that looks to me that it's an intended use of
20 the device. So as long as we have a device that satisfies all of the structure,
21 then that would be one way in which you would use the device. But I don't
22 see it as adding a structural limitation to the claim.

23 I guess to say it another way, I read that limitation. What structure are
24 we supposed to imagine there?

25 MS. FOUST: That the transformation needs to have some
26 applicability to an application or a removal process. So for example, one of

1 the references that's been cited against us, you get a change in the
2 appearance of the diaper. But a change in the appearance of the diaper
3 doesn't do anything to help me put it on or take it off.

4 JUDGE LEBOVITZ: Well, I think that if you change the appearance,
5 arguably you'd have to ask yourself, is that change in appearance a change
6 in, and then according to the claim, size, thickness, absorbency,
7 breathability, flexibility, rigidity, elasticity or tackiness?

8 MS. FOUST: I agree with you completely.

9 JUDGE LEBOVITZ: So I guess my question -- you just construed
10 that it seemed a little broader, and it seems to me that that's already
11 expressly in the claim.

12 MS. FOUST: I didn't mean to construe it more broadly. One of the
13 rejections is actually over --

14 JUDGE LEBOVITZ: Okay.

15 MS. FOUST: -- a piece of art that provides an indication of the
16 progress for that.

17 JUDGE LEBOVITZ: I understand.

18 MS. FOUST: And that change in the appearance I agree would not
19 qualify as a transformation under this definition. But this also helps guide us
20 in terms of what that transformation is doing, how it's useful. But what the
21 transformation is actually doing I suppose is how you would read that
22 structurally.

23 JUDGE PRATS: So you're talking about the Shaw reference is the
24 one that has the change in appearance?

25 MS. FOUST: Correct. When the diaper becomes wet, there is a -- the
26 examiner has asserted that there is a visual connection that is formed so that

1 the appearance of the diaper through an aperture or a window changes,
2 alerting you that it's time to change the diaper.

3 But that change in the appearance of the diaper, one, is not necessarily
4 a transformation, and two, does absolutely nothing to actually assist in
5 getting the diaper on or off. It tells you that you may want to start that
6 process, but it doesn't actually change the diaper in a way that makes the
7 changing process any easier. So it's not a change aid in that sense.

8 And in fact, Shaw describes -- Shaw and Glaug both describe their
9 inventions as training aids. They're really about alerting a child or a
10 caregiver to the status of the diaper and facilitating changes or facilitating
11 toilet training.

12 JUDGE MILLS: Don't we have a change in the rigidity in Shaw?
13 Because you have that panel 18 as breaking, so isn't there a change in
14 rigidity of this mat, what the examiner is calling a mat?

15 MS. FOUST: Possibly. We don't know. But I don't believe that's
16 necessarily inherent. While we're there, claims 19 and 25 --

17 JUDGE LEBOVITZ: Just to clarify, we're now -- we'll deal with the
18 Shaw rejection then since we seem to be into that?

19 MS. FOUST: It sounds like that's where we're going. I think that's
20 our next step. Claims 19 and 25 have been rejected over Shaw. I think the
21 major differences here -- the brief was fairly thorough, and I commend it to
22 your attention.

23 But the major difference that strikes me is that in Shaw, the changing
24 in the article are not distinct elements, and also the office action asserts that
25 alignment or visual connection being made is a connection in a sense of the
26 spec.

1 And again, I would point you to the specification and suggest that
2 there's nothing in the spec which suggests that a visual connection or an
3 alignment would be within our definition of a transformation.

4 Glaug is the other sort of a similar reference to Shaw. It's been cited
5 against claims 19, 21 and --

6 JUDGE LEBOVITZ: Can we go back just a minute?

7 MS. FOUST: Yes, please.

8 JUDGE LEBOVITZ: Because in the claim, I guess 25, it talks about
9 adapted to make the connection between the portions of the article. And
10 you're saying -- what I heard you say was, Well, the spec doesn't talk about
11 the connection being a visual connection or a mental connection; it's got to
12 be something physical.

13 And then I thought you said that that is true because the claim says
14 that it's adapted to transform at least a portion of the article. Did you say
15 something like that? I'm just trying to see where we can say that a
16 connection can't be a visual connection other than saying it's not one of the
17 specific embodiments in the spec. But as you know, we tend to read claims
18 broadly --

19 MS. FOUST: Correct.

20 JUDGE LEBOVITZ: -- because they can be amended at this point in
21 prosecution. So I'm looking to see, is there another hook into the claim that
22 would get you to exclude visual connections? And I was wondering whether
23 it was transform, but maybe not. I don't know.

24 MS. FOUST: Transform -- I think where I get hung up is that there's
25 some inherent ambiguity in words. And I understand not importing

1 limitations from the specification. I understand broadest reason for
2 interpretation.

3 But that interpretation still has to be informed by the specification so
4 that there's some context behind it. And this visual connection idea to me, it
5 seems superficially very appealing because typically when you place an
6 adjective in front of a noun, we're limiting that noun.

7 So we can talk about shoes and then talk about red shoes, and in a
8 Venn diagram, those would be completely overlapping circles. But
9 sometimes that adjective is a way of taking a noun into an entirely different
10 meaning. So for example, if we started talking about snowshoes, that's
11 really something different in structure and function.

12 And so my proposal would be that in reading a specification, there's
13 nothing that suggests that a visual connection is within the intended
14 meaning.

15 All of the connections discussed, I believe the specification
16 discussions, buttons and fasteners and velcro and even temporary magnetic
17 connections, at some point, you know, would an emotional connection
18 count? Would a social connection count? Would a mental connection
19 count?

20 All of those things are commonly described as connections, but there's
21 a reason we use an adjective with them, and they're really different.

22 JUDGE MILLS: Don't we actually have a transformation on our
23 movement within the mat that actually moves that color-coded portion into
24 the area? Isn't that a transformation into the opening aperture?

25 MS. FOUST: Yes. I would suggest that is a very specific movement
26 of pieces. And if you look at the specification, page 4, lines 7 through 14

1 provide if not an explicit, a very near explicit definition of movement and
2 transformation and distinguished between the two pieces.

3 And the spec consistently says you may have a movement, you may
4 have a transformation, or you may have a combination of the two. So I do
5 think that is very clearly in the spec defined.

6 JUDGE MILLS: So you're excluding movement by using the
7 terminology "transformed"?

8 MS. FOUST: Correct.

9 JUDGE PRATS: Okay. What about the idea that element 15, I
10 believe it is, actually gets smaller since it's an elastic portion? Isn't that a
11 change in size? It's shorter, and that's a change in size.

12 JUDGE LEBOVITZ: And we're still talking about the Shaw
13 reference?

14 JUDGE PRATS: Still talking about Shaw.

15 JUDGE LEBOVITZ: So 15 is the elastic portion?

16 JUDGE PRATS: Right.

17 MS. FOUST: Yes. Yes, that would be a change in size. However,
18 you still have a structural problem in Shaw about the changing in the article
19 not being distinct elements, and you also have a problem because, according
20 to the claim language, this is occurring during an application of the article or
21 removal of the article, this transformation occurs.

22 And in Shaw, this would occur during the use, so when the diaper is
23 actually wet, the frangible means of the bottom of that rubber band ruptures.
24 So typically, ideally, that would not be while you were applying or removing
25 the article.

26 JUDGE LEBOVITZ: But it would assist in the removal.

1 MS. FOUST: How so?

2 JUDGE LEBOVITZ: Because it would inform the mother or father or
3 caretaker that it was wet and needed to be removed.

4 MS. FOUST: It would notify the caretaker. Again, within the context
5 of the specification, I don't believe it would assist in removing the article.

6 JUDGE LEBOVITZ: So "assist" doesn't mean mentally assisting, it
7 means actually doing something physical?

8 MS. FOUST: It doesn't mean notifying, suggesting, asserting or
9 assessing. And indeed, consistently throughout the specification, "assisting"
10 refers to some change in the position or the status of the product that would
11 actually help you either wrap a garment or a disposable diaper or something
12 around an infant or would help you remove it from a child.

13 We're really talking about the physical changing process.

14 JUDGE LEBOVITZ: Why didn't you call it, rather than a changing
15 aid, a diaper, bandage or paper, because that --

16 MS. FOUST: So it would have been article-changing aid or --

17 JUDGE LEBOVITZ: That would have helped a lot of the
18 argumentation. You can say the preamble does make some structure here
19 that you need to take notice of.

20 MS. FOUST: Yes, that would be helpful. However, I think if we
21 look at the language on page 2 of the specification, again, consistently
22 there's discussion at line 19 about the device that assists the caregiver or
23 wearer in the process of changing articles.

24 If we look at the summary of the invention, change aids that assist in
25 the changing of articles. You know, hindsight is 20/20. If we had known

1 how this would to be interpreted or if we'd known which art was going to be
2 applied against us, we might have written the specification very differently.

3 But I think if you read the spec, it is reasonably clear and one of
4 ordinary skill in the art comes away from the spec with a firm impression
5 that we're talking about a physical changing process, not a visual process or
6 a mental process.

7 JUDGE LEBOVITZ: Okay.

8 JUDGE MILLS: Can we briefly visit Deagan, then?

9 MS. FOUST: Yes, let's talk about Deagan. Deagan also has some
10 structural deficits relative to the claims. Deagan has been cited against
11 claims 19, 21, 22 and 23. It was initially also cited in a rejection of claim
12 25. However, that was not addressed in the examiner's answer, and we
13 believe the rejection has been withdrawn. That's MPEP section 1207.02.

14 In regard to claim 19, Deagan also, when you line up the elements that
15 have been cited, there is difficulty maintaining a separation between what is
16 the changing aid and what is the article.

17 So for example, what's being cited as the claimed mat, a changing aid
18 comprising a mat, is actually the padding inside the helmet, which is itself
19 the article. And so under 102(b), we're really releasing the structure here in
20 order to get an anticipation rejection, which is not really allowed.

21 Further, in claim 19, we have the movement and transformation
22 difference, so the examiner has asserted that by moving the helmet or by
23 filling the bladder, you're transforming the helmet.

24 And again, looking at the specification at page 4, lines 7 through 14, I
25 would propose that those definitions are sufficiently clear that we
26 distinguished between movement and transformation.

1 With regard to claim 21, the assertion is that by inflating the bladder
2 of Deagan, you're changing the size of the helmet. And the difference here
3 is that fuller is not necessarily smaller.

4 I believe the analogy that my colleague drew in the appeal brief was
5 that if you partially fill a coffee cup, that doesn't make the coffee cup
6 smaller, it makes it partially full. And so we would assert that's not a change
7 in size, it's a change in fullness.

8 With regard to claim 22, the assertion is that the discharge of gas
9 when the bladder -- do you have a question?

10 JUDGE PRATS: Yes. I think that -- I'm looking at the examiner's
11 answer. I show that at page 3 of the examiner's answer, claims 19, 21 and
12 23 to 24 as being rejected by Deagan, and it looks like 22 is not subject to
13 this anymore. Or is it? Do you have a copy of the answer?

14 MS. FOUST: Indeed, we're willing to consider withdrawn. With
15 regard to claim 23, the assertion is that when the bladder is inflated in
16 Deagan, that bladder is taped to the top of the helmet and that tape ruptures.

17 And again, this is a case where I believe that the idea of activating or
18 deactivating an adhesive, which is what is recited in the claim, is sufficiently
19 described at page 10, lines 3 through 23, of the specification, where it talks
20 about using in particular a temperature to alter the properties of the adhesive
21 so that it's more or less tacky so that the behavior of the adhesive itself is
22 changing.

23 You're not simply overcoming or rupturing or breaking that adhesive
24 bond. You're actually changing the adhesive properties or the tackiness of
25 the adhesive. So I think the claim language can be distinguished by the
26 definition in the spec.

1 And with regard to claim 24, I believe the assertion was simply that
2 the bladder can be deflated, and therefore, it's temporary. But that would
3 have the structural deficits as appear relevant to claim 19.

4 We've covered a lot very quickly. Do you have any other questions?

5 JUDGE LEBOVITZ: Did we go through the Glaug reference? Did
6 we address Glaug?

7 JUDGE MILLS: I think you briefly touched on it.

8 JUDGE PRATS: I think we already did.

9 JUDGE LEBOVITZ: Were there any other questions on that?

10 JUDGE PRATS: No more questions about it. If you want to address
11 Glaug, you can.

12 MS. FOUST: Thank you. Glaug, we have the same issue with the
13 confusion of the mat and the article as you go through the examples. So
14 Glaug is an insert that's intended to be put in a training pant. It could be a
15 diaper, it could be a cloth garment.

16 And that insert has a chemical in it that, when exposed to urine, either
17 swells or changes temperature so that the wearer has some indication that
18 they've urinated. Again, this is a toilet-training aid.

19 And part of the concern is that if you treat that pad as the changing
20 aid, it does not, in fact, have any effect on the article that it's sitting within.
21 It has an effect on the wearer, has an effect on the user, but it doesn't
22 transform the article in any way.

23 And again, we would say that within the meaning of the specification
24 or within the context of the specification, Glaug doesn't assist in the removal
25 of the diaper.

1 JUDGE LEBOVITZ: Well, if it were interposed between the layers
2 and it changed its -- would it change its thickness when activated by the
3 liquid?

4 MS. FOUST: Possibly. But it's still not clear why that would assist in
5 the diaper-changing process.

6 JUDGE LEBOVITZ: Okay.

7 MS. FOUST: So you would have to both change the structure and
8 then explain why that would facilitate the removal.

9 So in summary, we believe that the 102 rejections require structural
10 modifications that are not permitted in an anticipation rejection and,
11 therefore, are erroneous. We would ask you to look to the consistent usage
12 of the language in the specification.

13 We realize that there's a fine line sometimes between importing claim
14 limitations, but the language here is fairly consistently used. The impression
15 that one of skill in the art would take from reading the specification really
16 draws to a physical process involving two distinct devices, and we think the
17 claim language is consistent with the specification.

18 JUDGE MILLS: Okay. I believe we understand your position, and
19 we'll take it under advisement when we're reviewing the case.

20 MS. FOUST: Thank you very much for your time.

21 (Whereupon, the proceedings at 2:07 p.m. were concluded.)
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